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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,025	03/01/2006	Takeshi Karato	1600-0170PUS1	1100
2292 7590 08/03/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
NUTTER, NATHAN M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/570,025

Applicant(s)

KARATO ET AL.

Examiner

Nathan M. Nutter

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This application contains claims 12-16 drawn to inventions nonelected with traverse in the reply filed on 23 October 2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Amendment

In response to the amendments filed 18 May 2009 and 10 June 2009, the following is placed in effect.

The rejection of claims 1-11, 17 and 18 under 35 U.S.C. 112, first paragraph, because the Specification, is not enabling for the several species recited, is hereby expressly withdrawn.

The rejection of claims 1-11, 17 and 18 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, as regards the phrases "such that at least three conjugated diene polymer chains are bonded" and "having a structure such that it has been allowed to react," only, is hereby expressly withdrawn. The rejection, as now stated, includes claim 17 since applicants have amended the offending language into that claim.

The rejection of claims 1-11, 17 and 18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention, as regards the phrase "having a structure such that it has been allowed to react," is hereby expressly withdrawn.

The rejection of claim 17 as being indefinite in the recitation of "obtainable," is hereby expressly withdrawn.

A new ground of rejection and a new ground of objection follow.

Specification

The amendment filed 10 June 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants have filed a paper in Japanese with no certification as to the veracity of the translation presented. As such, it is not deemed to be sufficient to amend the Specification, as proposed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The recitations in claims 1 and 17, of "such that...a part...is a functional group capable of reacting," in claim 1 at (lines 16-17 and 21-22), as amended, and in claim 17, as added by amendment, and "capable of reacting" in each of claims 4, 5 and 6, fail to define what is necessary to achieve the desired results, only that the compounds or constituents are "capable of reacting."

Claims 1-11, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

MPEP §§ 2163.06 and 714.02 state that, when Applicant presents an amendment to the claims, "Applicant should specifically point out the support for any amendments made to the disclosure." Examiner has re-read the Specification, and it is unclear what elements therein correspond to the claimed listing of constituents as amended into claim 1 and claim 17 as part (B), since the Specification does not utilize these terms, as listed.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The several recitations in claim 1 of the term "such that" at lines 11, 19, 26, et al. of the claim 1 text renders the claims as vague and confusing since it is not clear what is being claimed, since the structures are defined by being "capable of reacting" or "allowed to react." The structures are not shown nor described to any particularity.

The phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The recitation of "capable of reacting" in each of claims 1, 4, 5, 6 and 17, renders the claims as vague and confusing since the actual structure necessary for the reaction is not shown nor described with any particularity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al (US 6,767,969) taken in combination with Watanabe et al (US 4,657,965).

The reference to Sasagawa et al teaches the manufacture of a terminal modified conjugated diene polymer, as herein recited, that may comprise a weight average molecular weight of 60,000 to 600,000, within the range recited herein, and may have carbonyl, amido, amino, imino, pyridyl, epoxy, an alkoxyisilicon, halide, and other functional end groups. Note the paragraph bridging column 3 to column 4 for the molecular weights and column 6 (lines 4-27) for the functional groups. The reference teaches the blending of these polymers with other diene "polymers which may be functional group-modified rubbers." Note column 7 (lines 52-65) where the reference teaches the blending of two elastomers. The diene/vinyl aromatic monomer percentages are shown at column 4 (lines 4-21). The vinyl bond content is shown at the paragraph bridging column 2 to column 3. the inclusion of silica and carbon black is shown at the paragraph bridging column 8 to column 9. Use in automobile parts, which is deemed to include tires, is taught at column 9 (lines 29-43). Further, a skilled artisan would know of uses for compositions of diene rubbers to include tires. Further, note column 1 (lines 9-17).

The reference fails to teach the polyorganosiloxane bonded nonconjugated diene rubber in the rubber blend.

The reference to Watanabe et al teaches the manufacture of the polyorganosiloxane elastomer resin employed herein. Note column 2 (lines 15-41) for the polyorganosiloxane, identical to that recited herein. The conjugated diene polymer is shown at the paragraph bridging column 2 to column 3 and column 3 (lines 56-68). The addition of filler, including silica and carbon black, is shown at column 4 (lines 27-47).

Since Sasagawa et al show the use of functionalized rubber blends, and that those blends may include rubbers functionalized with carbonyl, amido, amino, imino, pyridyl, epoxy, an alkoxysilicon, halide, and other functional end groups, subsequent use of the rubber of Watanabe et al in the composition for the purpose, as taught therein, making a rubber composition "capable of being vulcanized with any of the vulcanizers," column 1 (lines 54 et seq.), would be prima facie obvious. Nothing unexpected has been shown on the record.

Response to Arguments

Applicant's arguments filed 18 May 2009 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1-11, 17 and 18 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, the phrase "capable of reacting" fails to delineate exactly what the constituent is, or what it may comprise. The Specification fails to delineate the genera sufficiently to establish the concept as fully disclosed or enabled.

With regard to the rejection of claims 1-11, 17 and 18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, applicants fail to provide reasoning as to why the claims may recite the vague language and be deemed as clear. The claim language, "capable of reacting," is not clear since it is not shown if it is reacted, reacted later, or what constituents or moieties provide the constituent with such "capability" of reacting. Further, as regards the phrase, "such that," it cannot be ascertained with any degree of certainty as to what may be included thereby. As such, the phrase renders the claims as vague.

With regard to the rejection of claims 1-11, 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al (US 6,767,969) taken in combination with Watanabe et al (US 4,657,965), it is pointed out that the reference to Watanabe et al clearly shows at column 3 (lines 19-26) when the reference teaches the polyorganosiloxane may have "one hydrocarbon group possessing at least five carbon atoms and having a carbon carbon double bond bonded to a silicon atom via at least one carbon atom." The reference then goes on to state "the polyorganosiloxane is required to contain at least two such hydrocarbon groups in the molecular unit," and may have no upper limit. This certainly embraces the concept of the instant claims. It is pointed out to applicants that Watanabe et al is cited for the reasons stated, and not as the basis of a separate rejection under 35 USC 102 or 35 USC 103 as postulated by applicants' arguments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

28 July 2009